

REMARKS

This response is intended as a full and complete response to the final Office Action mailed January 27, 2006. This response is also responsive to the Advisory Action mailed on May 2, 2006, and accompanies a Request for Continued Examination (RCE). In the final Office Action, the Examiner notes that claims 1 -27 are pending, claims 1-27 stand rejected. By this response, Applicant has amended claims 1, 9, 18, and 22.

In view of both the amendments presented above and the following discussion, Applicant submits that none of the claims now pending in the application are obvious under the provisions of 35 U.S.C. §103. Thus, Applicant believes that all of these claims are now in allowable form.

It is to be understood that Applicant, by amending the claims, does not acquiesce to the Examiner's characterizations of the art of record or to Applicant's subject matter recited in the pending claims. Further, Applicant is not acquiescing to the Examiner's statements as to the applicability of the art of record to the pending claims by filing the instant responsive amendments.

Amendments to the claims

By this response, Applicant has amended claims 1, 9, 18, and 22. The amendments to the claims are fully supported by the Specification, Claims and Drawings as originally filed. For example, the amendments to the claims are supported at least by page 51, lines 13-22 of the Specification.

Thus, no new matter has been added, and the Examiner is respectfully requested to enter the amendments.

35 U.S.C. §103 Rejection of Claims 22 and 25

The Examiner has rejected claims 22 and 25 under 35 U.S.C. §103(a) as being unpatentable over Lanier et al. (U.S. 5,588,104, hereinafter "Lanier '104") in view of Esch et al. (U.S. 5,283,639, hereinafter "Esch"). Applicants respectfully traverse the rejection.

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. The Lanier '104 and Esch

references fail to teach or suggest all of the limitations recited in claim 22, and thus fail to teach or suggest the Applicants' invention as a whole.

Specifically, the Lanier '104 and Esch references do not teach or suggest at least the portions of claim 22 which are emphasized as follows:

22. A method for placing virtual objects into video programs at a viewer's terminal in a television program delivery system, comprising:
receiving, at the viewer's terminal, a plurality of virtual objects comprising first virtual objects intended for the viewer's terminal and second virtual objects intended for other terminals, wherein the plurality of virtual objects are received through the television program delivery system;
receiving, at the viewer's terminal, a video program including one or more virtual object locations, the video program including virtual object information for placement of virtual objects into the video program, wherein the video program is received through the television program delivery system;
receiving, at the viewer's terminal, a group assignment matrix and a retrieval plan for the viewer's terminal and the other terminals, wherein the group assignment matrix and the retrieval plan are received through the television program delivery system, and the group assignment matrix comprises reception site groupings and program categories thereby the viewer's terminal stores information relating to the program categories of its group;
executing the retrieval plan at the viewer's terminal to instruct, based on the stored information relating to the program categories of its group, the viewers terminal to select one or more of the plurality of virtual objects, wherein the executing step includes comparing the virtual object information and the received virtual objects to select virtual objects for placement in the virtual object locations; and
inserting the selected virtual objects into the virtual object locations. (emphasis added).

The Lanier '104 reference discloses a method and apparatus for creating virtual worlds where users may manipulate pictorial objects on a computer display. The method uses a computer to display the virtual world as a data flow network having a plurality of interconnected units. An interactive program allows the appearance of the plurality of interconnected units to be changed.

The Lanier '104 reference further does not teach or suggest "receiving, at the viewer's terminal, a group assignment matrix and a retrieval plan for the viewer's terminal and the other terminals, wherein the group assignment matrix and the retrieval plan are received through the television program delivery system, and the group assignment matrix comprises reception site groupings and program categories thereby the viewer's terminal stores information relating to the program categories of it's group;" and "executing the retrieval plan at the viewer's terminal to instruct, based on the information relating to the program categories of it's group, the viewers terminal to select one or more of the plurality of virtual objects," as recited in claim 22.

09/609,286

Page 10 of 15

Regarding the Lanier '104 reference, the Examiner acknowledges (emphasis added below):

"However, Lanier fails to teach receiving through the television program delivery system, at the view's terminal, the virtual objects;

Receiving, at the viewer's terminal, a group assignment matrix and a retrieval plan for the view's terminal and the other terminal, wherein the group assignment matrix and retrieval plan are received through the television program delivery system." (Page 3 of the 1/27/2006 Office Action).

The Applicants respectfully further note that the the Lanier '104 reference also fails to teach or suggest executing the retrieval plan at the viewer's terminal as recited in claim 22.

The Esch reference fails to bridge the substantial gap between the Lanier '104 reference and the Applicants' invention as recited in claim 22. The Esch reference discloses a media system having a central site and a remote site for customizing video and audio presentations.

The Examiner asserts that the Esch reference discloses receiving at a viewer's terminal a group assignment matrix and a retrieval plan. However, the Applicants respectfully disagree and submit that it is difficult to ascertain exactly what part of the Esch reference the Examiner is alleging teaches the group assignment matrix. The Examiner cites column 11, lines 50-65, column 1, lines 30-40 and column 1, 42-column2, lines 70, as allegedly providing this teaching. For example, the paragraph of the Esch reference at approximately column 11, lines 50-65, discloses:

The multiple media delivery network of the present invention is unique in that the system displays full motion video and audio; replaces an existing audio track with analog or digital audio in another language; overlays customized text on full motion video or phototext content; and customizes phototext content automatically at each downlink. The content, whether full motion, phototext, digital audio, or any combination is broadcast quality "clean" switch and the content is automatically synchronized to the video signal. The content provider, be it a cable network, an advertiser, news programmer, or television listing service can precisely customize content, display it to exact demographic audiences, and receive a single accounting of the use of the content.

Thus, the Esch reference discloses that the system customizes audio and video, and that a cable network can display the customized video to an audience at the facility (i.e. remote site) and not a viewer's terminal. Thus, this portion of the Esch reference does not teach or suggest receiving a group assignment matrix and a retrieval plan at a viewer's terminal, wherein the group assignment matrix comprises reception site

471270_1.DOC

groupings and program categories thereby the receiver stores information relating to the program categories of its group.

The other portions of the Esch reference cited by the Examiner as allegedly teaching receiving a group assignment matrix and a retrieval plan also fail to provide such alleged teachings. For example, the paragraph at column 2, lines 31-61, discloses a matrix switch. However, the matrix switch is not received by the facility (i.e. remote site) but is instead a hardware element present at the remote site. Furthermore, as discussed above the matrix switch of the facility is silent to the feature of the group assignment matrix having reception site groupings and program categories thereby the receiver stores information relating to the program categories of its group because the Esch reference does not teach or suggest the group assignment matrix of the present invention.

Similarly, the Esch reference also does not teach or suggest executing the retrieval plan at the viewer's terminal to instruct, based on the information relating to the program categories of its group, the viewer's terminal to select one or more of the plurality of virtual objects.

Therefore, the Lanier '104 and Esch references, alone or in combination, fail to teach Applicants invention, as recited in claim 22, as a whole.

As such, Applicants submit that independent claim 22 is not obvious and fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder. Furthermore, claim 25 depends directly from independent claim 22 and recites additional features thereof. As such and at least for the same reasons as discussed above, Applicants submit that dependent claim 25 also is not obvious and fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder.

Therefore, Applicants respectfully request that the Examiner's rejection be withdrawn.

35 U.S.C. §103 Rejection of Claims 1-6, 8-14, 16-21, 23, 24, 26 and 27

The Examiner has rejected claims 1-6, 8-14, 16-21, 23, 24, 26 and 27 under 35 U.S.C. §103(a) as being unpatentable over Lanier '104 in view of Lanier et al. (U.S. Patent 5,588,139, hereinafter "Lanier '139") further in view of Esch. Applicants respectfully traverse the rejection.

09/609,286

Page 12 of 15

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. The Lanier '104, Lanier '139 and Esch references fail to teach or suggest all of the limitations recited in claim 1, and thus fail to teach or suggest the Applicants' invention as a whole.

Specifically, the Lanier '104, Lanier '139 and Esch references do not teach or suggest at least the portions of claim 1 which are emphasized as follows:

1. A method for placing virtual objects in virtual object locations in a video program at a viewer's terminal in a television program delivery system, comprising:
 - receiving, at the viewer's terminal, a plurality of virtual objects for use with one or more of the virtual object locations in the video program, wherein the plurality of virtual objects are received through the television program delivery system and comprise first virtual objects intended for the viewer's terminal and second virtual objects intended for other terminals;
 - storing the plurality of virtual objects in the viewer's terminals;
 - receiving, at the viewer's terminal, a group assignment matrix and a retrieval plan for the viewer's terminal and the other terminals, wherein the group assignment matrix and the retrieval plan are received through the television program delivery system, and the group assignment matrix comprises reception site groupings and program categories thereby the viewer's terminal stores information relating to the program categories of its group;
 - executing the retrieval plan at the viewer's terminal to instruct, based on the stored information relating to the program categories of its group, the viewer's terminal to select one or more of the plurality of virtual objects; and
 - inserting the selected one or more of the received plurality of virtual objects into one or more of the virtual object locations during a display or storage of the video program at the viewer's terminal.

The Lanier '104 reference discloses a method and apparatus for creating virtual worlds where users may manipulate pictorial objects on a computer display.

The Lanier '139 reference discloses a computer model of a virtual environment which is modified by input from participants in the virtual environment.

Regarding the Lanier '104 and Lanier '139 references, the Examiner acknowledges that the Lanier '104 and Lanier '139 references fail to teach or suggest receiving the group assignment matrix and retrieval plan at the viewer's terminal through the television program delivery system, and executing the retrieval plan at the viewer's terminal to select one or more of the plurality of virtual objects. The Applicants respectfully thank the Examiner for this acknowledgment of the shortcomings of the Lanier '104 and Lanier '139 references.

The Esch fails to bridge the substantial gap between the Lanier '104 and Lanier '139 references and the claimed invention. The Esch reference discloses a media

471270_1.DOC

09/609,286

Page 13 of 15

system having a central site and a remote site for customizing video and audio presentations. The Applicants note that the remote site discussed in the Esch reference is not a viewer's terminal in a television program delivery system. Instead, the remote site discussed in the Esch reference is a media processing facility.

The Examiner further alleges that the Esch reference discloses receiving at a viewer's terminal a group assignment matrix and a retrieval plan. Therefore, the Applicants respectfully disagree and submit that it is difficult to ascertain exactly what part of the Esch reference the Examiner is alleging teaches the group assignment matrix. The Examiner cites column 11, lines 50-65, column 1, lines 30-40 and column 1, 42 - column 2, lines 70, as allegedly providing this teaching. For example, the paragraph of the Esch reference at approximately column 11, lines 50-65, discloses:

The multiple media delivery network of the present invention is unique in that the system displays full motion video and audio; replaces an existing audio track with analog or digital audio in another language; overlays customized text on full motion video or phototext content; and customizes phototext content automatically at each download. The content, whether full motion, phototext, digital audio, or any combination is broadcast quality "clean" switch and the content is automatically synchronized to the video signal. The content provider, be it a cable network, an advertiser, news programmer, or television listing service can precisely customize content, display it to exact demographic audiences, and receive a single accounting of the use of the content. (emphasis added).

Thus, the Esch reference discloses that the system customizes audio and video, and that a cable network can display the customized video to an audience. However, this does not teach or suggest that a viewer's terminal receives a group assignment matrix and a retrieval plan. As amended, the group assignment matrix comprises reception site groupings and program categories thereby the receiver stores information relating to the program categories of its group, which is not taught or suggested by Esch. This portion of the Esch reference does not teach or suggest receiving a group assignment matrix and a retrieval plan at a viewer's terminal.

The other portions of the Esch reference cited by the Examiner as allegedly teaching receiving a group assignment matrix and a retrieval plan also fail to provide such alleged teachings. The group assignment matrix includes "reception site groupings and program categories thereby the viewer's terminal stores information relating to the program categories of its group." For example, the paragraph at column 2, lines 31-61, discloses a matrix switch. However, the matrix switch is not received by

471270_1.DOC

09/609,286

Page 14 of 15

the facility (i.e. remote site) but is instead a hardware element present at the facility. Furthermore, Esch is silent with respect to the group assignment matrix having reception site groupings and program categories thereby the receiver stores information relating to the program categories of its group.

Similarly, the Esch reference also does not teach or suggest executing the retrieval plan at the viewer's terminal to instruct, based on the information relating to the program categories of its group, the viewer's terminal to select one or more of the plurality of virtual objects.

Therefore, the Lanier '104, Esch and Lanier '139 references, singly or in combination, fail to teach Applicants invention, as recited in claim 1, as a whole.

As such, Applicants submit that independent claim 1 is not obvious and fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder. Moreover, independent claims 9, 18 and 22 include substantially similar relevant limitations as those discussed above in regards to claim 1. Therefore, independent claims 9, 18 and 22 are not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Furthermore, claims 2-6, 8, 10-14, 16-17, 19-21, 23, 24, 26 and 27 depend, either directly or indirectly, from independent claims 1, 9, 18 and 22 and recite additional features thereof. As such and at least for the same reasons as discussed above, Applicants submit that these dependent claims are also not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder.

Therefore, Applicants respectfully request that the Examiner's rejection be withdrawn.

35 U.S.C. §103 Rejection of Claims 7 and 16

The Examiner has rejected claims 7 and 16 under 35 U.S.C. §103(a) as being unpatentable over Lanier '104 in view of Lanier '139 further in view of Esch further in view of de Hond (U.S. Patent 5,737,533, hereinafter "Hond"). Applicants respectfully traverse the rejection.

Claims 7 and 16 depend, either directly or indirectly, from independent claims 1 and 9, and recite additional features thereof. Moreover, claims 1 and 9 are patentable over the Lanier '104, Lanier '139 and Esch references at least for the reasons discussed above. Accordingly, any attempted combination of the Lanier '104, Lanier '139 and

471270_1.DOC

09/609,286

Page 15 of 15

Esch references with any other additional references, in a rejection against the dependent claims, would still result in a gap in regards to the rejection against the independent claims. As such, Applicants submit that dependent claims 7 and 16 are also not obvious and are patentable under 35 U.S.C. §103.

CONCLUSION

Thus, Applicant submits that none of the claims presently in the application, are obvious under the provisions of 35 U.S.C. §103. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Jasper Kwok or Eamon J. Wall, at (732) 530-9404, so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

Dated: 6/2/06

E J Wall
Eamon J. Wall
Registration No. 39,414
Attorney for Applicant

PATTERSON & SHERIDAN, LLP
595 Shrewsbury Avenue, Suite 100
Shrewsbury, New Jersey 07702
Telephone: 732-530-9404
Facsimile: 732-530-9808

471270_1.DOC